

REMARKS

Claim Rejections Based on 35 U.S.C. §112

Claims 1-18, 21, and 22 are rejected under 35 U.S.C. § 112, second paragraph, and the reasons given in the action are because “[t]here is insufficient antecedent basis for” the object in claim 1 “as an object has not been positively recited” and because claims 2-18, 21, and 22 depend from claim 1.

Applicant submits that the recitation of “a potentially dangerous object” in the preamble of claim 1 is sufficient antecedent basis for reciting the object in the body of claim 1, in claim 4, and in any of the other dependent claims rejected under 35 U.S.C. § 112, second paragraph.

Applicant respectfully requests that the Examiner cite specific controlling statutory language, case law, and/or rules if the Examiner intends to maintain this rejection under 35 U.S.C. § 112, second paragraph, given that applicant submits that all of the claims are proper.

Claim Rejections Based on 35 U.S.C. §103

Claims 1-15 and 17-22 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,056,122 to Takeuchi (hereinafter “Takeuchi”) in view of Published U.S. Patent Application No. US 2003/0076011 A1 to Brownfiel, Jr. (hereinafter “Brownfiel”).

Claim 16 is rejected under 35 U.S.C. § 103(a) over the combination of Takeuchi, Brownfiel, and U.S. Patent No. 6,708,697 to Ziff (hereinafter “Ziff”).

Of these rejected claims, the only independent claim are original claims 1 and 19.

Applicant respectfully disagrees with all of the rejections under 35 U.S.C. § 103(a), and applicant provides the following remarks in this regard.

Applicant initially notes that the combination of Takeuchi and Brownfiel is the main basis for the Examiner's rejection of applicant's claims and that Ziff is a secondary reference. Applicant thus focuses these remarks on Takeuchi and Brownfiel. Applicant will show in these remarks that the combination of Takeuchi and Brownfiel fails to teach or suggest the inventions recited in applicant's pending claims. Applicant also submits that Ziff, whether taken alone or in combination with Takeuchi and Brownfiel, fails to teach or suggest the inventions recited in applicant's pending claims.

Applicant particularly disagrees with the assertion in the action that a person skilled in the art would have been motivated to combine Takeuchi and Brownfiel. Applicant submits that at the priority date it was not known, and there was not considered to be any advantage, to provide:

"an inspection unit...to provide a sealed airtight environment for manual inspection of the object... and, a transportation unit...to wholly receive the inspection unit and then close to provide a further sealed airtight environment containing the inspection unit...", as recited in original independent claim 1.

Also, as of the priority date, it was not known, and there was not considered to be any advantage, to provide:

"a substantially rigid inspection unit adapted to provide a sealed air tight environment... and, a substantially rigid transportation unit adapted to wholly receive and secure the inspection unit after user inspection of the mail and to provide a further sealed airtight environment...", as recited in original claim 19.

Applicant respectfully submits that the Examiner has based the obviousness rejections on a hindsight reconstruction of the invention in view of applicant's own disclosure.

Brownfiel is wholly silent on provision of a *"transportation unit"*, *"to wholly receive the inspection unit and then close to provide a further sealed airtight environment containing the inspection unit"*, as recited in applicant's original claim 1. The Examiner seemingly alleges that safe transportation of the inspection unit of Brownfiel is a routine requirement when suspect mail has been detected, and that a sealed airtight transportation unit, into which the inspection unit is received, is disclosed by Takeuchi. Applicant disagrees.

Applicant submits that the Examiner is impermissibly using hindsight and is importing additional concepts with inventive merit into a reading of Takeuchi and Brownfiel. Nowhere in the combination of Takeuchi and Brownfiel is it taught or suggested that an inspection unit should be combined with a transportation unit and able to be readily transported if a suspect mail item is identified.

At the priority date, it was not known, and therefore not considered to be any advantage, to have a combinable inspection unit and transportation unit when further analysis of a suspect mail item or object was required. Instead, it was the typical solution that an analysis or testing team was dispatched to the location where the suspect item had been identified. In accordance with this accepted solution, Brownfiel only discloses a mail inspection unit for the recognition of biologically contaminated contents. Brownfiel is not directed at, and does not suggest, an inspection unit intended to be transported.

Thus, part of the solution devised by applicant involves actual recognition of the need to transport suspect objects or mail items to a remote analysis facility, rather than, for example, placing an emergency call for an emergency response team to attend on-site.

In identifying the unrecognized need to transport a suspect object or mail item from an inspection location to a testing or analysis location, applicant had to solve the further problem of how to provide a safe inspection unit and additionally safely and securely transport the complete inspection unit to a testing facility.

Thus, it is incorrect for the Examiner to assume that a person skilled in the art, as of the priority date, would have read Takeuchi and/or Brownfiel with any understanding or concept of the desirability of transporting the inspection unit of Brownfiel. Applicant disagrees that there was any motivation to combine Takeuchi and Brownfiel as of the priority date.

In contrast, applicant submits that a skilled person in the art would have realized that Brownfiel is simply a more compact version of laboratory glove-boxes that are typically bulky. The skilled person in the art would not have assumed the inspection unit of Brownfiel is provided or designed to be transportable within a secure transportation unit, as this was not an acknowledged step to take at the priority date. There is nothing whatsoever in Brownfiel to suggest to the skilled person that the inspection unit should be transported, and similarly, applicant asserts it was not known in the relevant art, at the priority date, that suspect mail items should be transported off-site unless by a specialized response team with specialized equipment.

Applicant has recognized that, firstly, an inspection unit should be able to be readily contained and transported by a non-expert user, which is not disclosed or suggested by Takeuchi or Brownfiel. Applicant has furthermore recognized that the inspection unit should be enclosed in a transportation unit for sufficiently safe transportation.

Applicant thus respectfully submits that the Examiner has used impermissible hindsight, firstly, to assert that the inspection unit of Brownfiel is intended to be transported or is transportable, and, secondly, to assert that there is any motivation to combine with the transportation unit from Takeuchi.

Takeuchi discloses "transportable storage container suitable for storing an expensive heavy product such as metallic dies, metallic dies..." (col. 1, lines 54-58) that is capable of "transporting a heavy article housed in the container even when the container is transported by a forklift or a carrier" (col. 1, lines 2-4). As such, applicant disagrees with the Examiner that a skilled addressee would consider the "expensive heavy product" of Takeuchi to be the inspection unit of Brownfiel.

Brownfiel simply discloses a sealed inspection unit including a base, a lid, and rubber gloves for bench top manual inspection of a mail item (paragraph 005, 037). There is no disclosure in regard to transportation of the inspection unit.

Therefore, without the hindsight reconstruction of the invention in view of applicant's own disclosure, there would be no motivation to combine Takeuchi and Brownfiel.

Furthermore, there are substantial secondary considerations that assist in demonstrating the non-obviousness of applicant's claimed inventions, and applicant's request the Examiner's consideration of them. Applicant has achieved commercial success in creating and developing a business selling products embodying the claimed apparatus/device. The inspection and transportation apparatus/device has been sold in many countries around the world and has been commercially successful, in part at least because no similar product has previously been devised or offered for sale.

It was not the case that a containment and testing enclosure, such as that disclosed by Brownfiel, would be simply inserted into a transportable storage container, as suggested by the Examiner. This simply was not done or recognized at the priority date of the present application, as the desirability of transporting an inspection unit had not been conceived. If the Examiner's assertions in this regard were correct, applicant would likely not have achieved the level of commercial success for the apparatus of the present application.

Applicant's solution lies at least partially in the actual recognition of a problem that presented an unresolved need to easily transport an inspection unit of suspect objects.

Applicant notes that amended claim 12 recites that the transportation unit is double walled with two independent airtight seals. Takeuchi does not disclose that a transportation unit, that receives an inspection unit, should be double walled with two independent airtight seals. This feature of claim 12 provides a technical advantage in improving safety when transporting the suspect or potentially dangerous object.

Applicant also notes that amended claim 21 recites that the inspection unit is provided with a sealable port to receive a probe and that amended claim 22 recites that the inspection unit is provided with a further sealable inspection port having a diameter substantially larger than the sealable port of claim 21. These features are neither disclosed nor suggested in Takeuchi or Brownfield. A further sealable inspection port having a diameter substantially larger than the sealable port provides a technical advantage in that the further sealable inspection port can be used for a gloved hand or equipment to be passed into the inspection unit, again without having to break the main seal of the inspection unit. The ports also provide the ability for other uses, such as to equalize air pressure, to create a vacuum or to introduce a suitable gas into the inspection unit.

Claim Changes

Applicant has made some changes to some of the claims, but none of the changes relate to the rejections in the Office's action. Without prejudice, applicant has amended claims 12, 16, 17, 21, and 22 and also canceled claims 15 and 20.

Support for the change to original claim 12 can be found at, for example, lines 14-16 of page 10 of the application. Support for the change to claim 16 can be found at, for example, lines 4-7 of page 8. Support for the change to claim 17 can be found at, for example, lines 9-10 of page 10. Support for the changes to claims 21 and 22 can be found at, for example, the text from line 9 of page 8 to line 5 of page 9 and also in figures 5 and 6.

CONCLUSION

In view of the foregoing, applicant requests reconsideration of all rejections in the Office's action, and applicant also requests allowance of all pending claims in due course.

If a personal communication will expedite prosecution of this application, the Examiner is invited to call applicant's undersigned representative at the number provided below.


Dated: September 9, 2009

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